

REMARKS/ARGUMENTS

Claims 35-58 are pending. The Office Action rejects claims 35-58 under 35 U.S.C. §112, first paragraph, rejects claims 35, 37-42, 44-49, 51-58 under 35 U.S.C. §103 as unpatentable over Gifford (U.S. 6,205437) in view of Bishop (U.S. Pub. 2004/0243520) and Schwartz (U.S. Pub. 2001/0044787), and rejects claims 36, 43, and 50 under §103 as unpatentable over Gifford, Bishop and Schwartz, in further view of Baltzley (U.S. Pub. 2001/0014158). These rejections are respectfully traversed.

35 U.S.C. §112 Rejections

The Office Action rejects claims 35, 42, and 49 under §112, ¶ 1 due to use of the term “authorization service.” These claims are amended to recite an “authentication service,” rendering this rejection moot.

Support for the other features identified in the Office Action and for the amendments presented herein can be found throughout the specification, drawings, and claims as originally filed. For the Examiner’s convenience, it is noted that the identified features are described in the specification as originally filed at least at page 9, lines 5-22, page 18, line 18 through page 19, line 12, and throughout the drawings. Support for claims 56-58 can be found at least at page 10, lines 20-26, page 15, line 8 through page 16, line 22, and throughout the drawings. These citations are not intended to be exhaustive, and support may be found at various other places throughout the application.

35 U.S.C. §103 Rejections

Claims 35-58 stand rejected under 35 U.S.C. §103. These rejections are respectfully traversed as described below.

Claims 35, 42, and 49

To support a *prima facie* case of obviousness, the Examiner must demonstrate that each feature recited in the claims is found in the cited art, or provide explicit reasoning to support the finding that the features would be obvious to one of skill in the art at the time the invention was made. See M.P.E.P. §§ 2141, 2142.

Independent claim 35 recites, *inter alia*,

receiving a selection of the first payment instrument from the buyer.

Independent claims 42 and 49 recite similar features. The Office Action fails to show where such a feature is disclosed or suggested by any cited reference, and provides no analysis to indicate why this feature would have been obvious to one of skill in the art. For at least this reason, the Office Action fails to support a *prima facie* case of obviousness, and the rejection should be withdrawn.

Further, insofar as the Office Action addresses the recited “payment instrument,” the Office Action’s analysis is inconsistent. The Office Action asserts that Gifford discloses linking the PKI key pair to at least a **first payment instrument** in a description of signing a payment order with a smart card. *See* Office Action, p. 4. The Office Action also asserts that Gifford discloses a **plurality of payment instruments** in a description of a missing information document in which a user can provide an account number. *See* Office Action, p. 4-5. The smart card signing process does not refer to the payment types cited as allegedly disclosing payment instruments, and the missing information document does not describe the use of multiple smart cards. Thus, it is unclear what item in Gifford, if any, the Office Action intends to interpret as the recited receiving a selection of the first **payment instrument** from the buyer. Regardless, the Office Action fails to show where this feature is disclosed or suggested by the cited art, and fails support a *prima facie* case of obviousness. For at least this reason, the rejection should be withdrawn.

Claims 40, 47, and 54

Claim 40 recites, *inter alia*,

retrieving a buyer profile from the database, the buyer profile being linked to the PKI key pair and including a plurality of payment instruments...;

sending data from the buyer profile to the buyer over the network; and

receiving a selection of one of the plurality of payment instruments...from the buyer.

Claims 47 and 54 recite similar features. The Office Action asserts that Gifford discloses receiving a selection of one of the plurality of payment instruments (interpreted as “means of payment”) at column 5, lines 34-50.

However, Gifford merely describes allowing a user to select a type of payment (Visa, MasterCard, etc.). This disclosure of a broad payment type does not correspond to the recited **payment instrument**, at least because there is no suggestion that the payment type is linked to the buyer’s PKI pair, or that a buyer can be authorized to use the payment type. For example, Gifford does not suggest that a user can select “Visa” and thereby select a specific Visa account that the buyer is authorized to use, or that Gifford’s disclosure of “Internet card, Mastercard, Visa, American Express and Discover” in Figure 4 indicates that the buyer is authorized to use each payment type, or that each payment type is included in the buyer’s profile.

Such an interpretation is inconsistent with Gifford’s disclosure, as can be seen by considering the reason that Gifford describes the “means of payment” cited by the Office Action. Gifford’s system uses a document to collect missing information from a user:

FIG. 4 is a missing payment information document that is used to gather user account information for the requested purchase in an HTML form. ... [D]ialog box 13 is used to enter an account number...FIG. 5 is a fulfillment document 18 that is produced once valid account information is provided to the missing payment information document in FIG. 4.

Col. 5, lines 33-35, 48-50 (emphasis added). Gifford’s Figure 4 also shows that the user must provide an account number 13. If the user must provide the account information, he is not **selecting** a payment instrument as recited in the claims. Gifford’s system simply does not send buyer profile data or receive a selection of one of a plurality of payment instruments that are linked to the buyer’s profile.

In fact, the Office Action admits that Gifford fails to disclose sending a buyer profile to the buyer over the network, but asserts that this is an “inherent step.” To establish inherency, the record must show that the alleged inherent feature is necessarily present in the cited art; the fact that a certain characteristic may be present is insufficient. See M.P.E.P. §2112, Part IV. (citing

In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), *re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981)). Thus, to support the assertion of inherency, the Examiner must show that Gifford's system necessarily sends data from a buyer's profile to the buyer and receives a selection of one of a plurality of payment instruments included in the profile. The Office Action fails to make such a showing. Rather, the Office Action merely asserts that the features are inherent.

The allegedly-inherent feature not necessarily present in Gifford, since Gifford allows the user to provide account information without selecting one of a plurality of payment instruments included in the buyer's profile. In fact, Gifford explicitly describes an alternative configuration to that suggested as inherent by the Office Action. Specifically, Gifford's missing payment information document presupposes that the user can provide all the details regarding a means of payment used for a purchase to the system. Col. 5, lines 33-47. Thus, in at least this configuration, there is no plurality of payment instruments provided from the buyer's profile from which the user selects – the buyer is providing all the information about a single payment instrument, which may not even be present in a buyer profile at all. For at least this reason these features are not inherent in Gifford's system, and the Office Action fails to make the showing required to support a finding of inherency.

Claims 56-58

As noted above, to support a *prima facie* case of obviousness, the Examiner must show that each claimed feature is shown in the cited art or provide reasoning to support the finding that the features would be obvious at the time the invention was made. M.P.E.P. §§2141, 2142. In addition, the analysis supporting a rejection under §103 must be made explicit. That is, an obviousness rejection cannot be sustained by mere conclusory statements; there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. M.P.E.P. §§ 2141, 2142 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 at 1396 (2007)). Where an articulated reasoning to support the legal conclusion is not provided, the

examiner fails to make a *prima facie* case of obviousness, and the applicant is under no obligation to produce evidence or argument in favor of patentability. M.P.E.P. §2142.

Claims 56-58 recite, *inter alia*,

receiving confirmation that the buyer is authorized to use the first payment instrument **prior to** receiving the authorization request and **prior to** receiving the selection of the first payment instrument.

In rejecting these claims under §103, the Office Action merely states that “the combination of Gifford, Bishop, and Shwartz discloses these features” and references an earlier rejection of claims 35 and 42. Office Action, p. 8. However, claims 35 and 42 do not recite “receiving confirmation that the buyer is authorized to use the first payment instrument” at all. The Office Action fails to show that the cited combination of references discloses at least this feature, or to provide any reasoned explanation of why this feature would be obvious to one of skill in the art based on the cited references. For at least this reason the rejection of claims 56-58 is improper.

Further, even if the cited references disclose the features of receiving confirmation that the buyer is authorized to use the first payment instrument, receiving the authorization request, and receiving the selection of the first payment instrument (which Applicants do not concede), the Office Action fails to provide a reasoned explanation of why it would be obvious to receive confirmation that the buyer is authorized to use the first payment instrument **prior to** receiving the authorization request and **prior to** receiving the selection of the first payment instrument. The Office Action provides no reasoning to indicate why it would have been obvious to modify the cited references to perform the recited operations in the recited order. For example, the Office Action cites to Gifford’s payment order (col. 6, lines 16-32) as disclosing the recited receiving the authorization request (see Office Action p. 4), and Gifford’s “missing payment information document” (col. 5, lines 34-50) as disclosing the recited “receiving selection of the first payment instrument” (see Office Action p. 5-6). However, no reasoning is provided as to why one of skill in the art would modify Gifford to first receive confirmation that the buyer is authorized to use the first payment instrument **before** receiving a payment order or a missing payment information document.

For at least these reasons, the Office Action fails to provide explicit reasoning sufficient to support a *prima facie* case of obviousness with respect to at least claims 56-58. Therefore, Applicants are under no obligation to provide further evidence or argument in favor of patentability for these claims, and the rejection should be withdrawn.

A Subsequent Office Action Should Not Be Made Final

As described above, the Office Action fails to allege or show that the cited references disclose each and every feature in the claims. Specifically, the Office Action fails to allege or show that the cited art discloses at least the features of receiving a selection of the first payment instrument from the buyer and receiving confirmation that the buyer is authorized to use the first payment instrument prior to receiving the authorization request and prior to receiving the selection of the first payment instrument.

These features were previously presented in claims 35, 42, 49, and 56-58. The present Amendment retains the originally-presented form and content of these features. Since the Examiner has not previously addressed these features and they remain unchanged by the present amendment, any subsequent rejection of these claims that addresses these features will necessarily include a new ground of rejection that is not necessitated by amendment of the claims or information in an IDS submitted during the period set in 37 C.F.R. §1.97(c).

Such an Office Action cannot properly be made final, even if it includes other grounds of rejection that are necessitated by an amendment. *See* M.P.E.P. §706.07(a). It is also respectfully noted that any new position or rationale in a rejection constitutes a new ground of rejection, including: reliance on a new portion of a reference, presentation of a new reference, a new factual finding, application of a new supporting position or rationale, and presenting a new claim interpretation. *See, e.g., In re Kumar*, 418 F.3d 1361, 76 USPQ2d 1048 (Fed. Cir. 2005); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976).

For at least this reason, a subsequent Office Action rejecting at least these claims should not be made final.

CONCLUSION

The dependent claims are allowable at least for the same reasons as described with respect to the independent claims. Solely to advance prosecution of the present application, several dependent claims are discussed in further detail herein. However, the omission of a dependent claim or feature from the discussion is not an indication of agreement with the Office Action's analysis.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 202-481-9900.

Respectfully submitted,

/ASKamlay/
Aaron Kamlay
Reg. No. 58,813

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 202-481-9900
Fax: 415-576-0300
61655585 v1